

**REMARKS**

It is noted that, notwithstanding any claim amendments made herein, Applicants' intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution..

Claims 1, 3, 4, and 7-53 are all of the claims pending in the present Application. Claims 1, 7, 16-18, and 46-51 stand rejected under 35 USC §112, second paragraph, as being indefinite.

Claims 34-36 stand rejected under 35 USC §103(a) as unpatentable over US Patent 5,434,917 to Naccache et al., further in view of US Patent 5,974,150 to Kaish et al. Claims 1, 3, 4, 7-9, 19-23, 25-33, 38-40, 42, and 47 stand rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish, and further in view of US Patent 6,543,685 to Lien et al. Claims 41, 44, 52, and 53 stand rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish and Lien, and further in view of US Patent 6,131,090 to Basso, et al.

Claim 45 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish and Lien, and further in view of US Patent 5,257,389 to Liu et al. Claims 10-13 and 46 stand rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish and Lien, and further in view of US Patent 6,297,888 to Noyes et al. Claims 14, 37, and 49 stand rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish and Lien, and further in view of US Patent 6,155,605 to Bratchley et al.

Claim 48 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish and Lien, and further in view of US Patent 6,233,339 to Kawano et al. Claim 51 stands rejected under 35 USC §103(a) as unpatentable over Naccache, further in view of Kaish and Lien, and further in view of US Patent 3,795,805 to Swanberg et al.

Applicants gratefully acknowledge the Examiner's indication that claims 15-18, 24, and 50 would be allowable if rewritten in independent format and, as appropriate, in a manner that overcomes the rejection under 35 USC §112, second paragraph. However, Applicants believe that all the claims are allowable.

Therefore, these rejections are respectfully traversed in view of the following discussion.

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## I. THE CLAIMED INVENTION

As described and claimed, for example by claim 39, the present invention is directed to a method of guaranteeing authenticity of an object that includes or has attached thereto at least one of a chip with a recording support and another recording support.

Attached to the object is a first sample of material obtainable by at least one of a chemical process and a physical process having a characteristic that samples generated by the process are random and non-reproducible. The first sample is associated with a first number obtained by reading the first sample using a first reader of a specific sort.

An exact value of the first number is recorded on at least one of the recording supports at said time of production in an exactly readable way, so that the first number can be checked against a later reading made with any reader of the specific sort at each time of verification of the object, thereby providing a first verification that verifies that a sample being read at the verification of the object is indeed the first sample.

At the time of production, at least one encrypted version of the first number is formed. At least one of the encrypted versions of the first number is also recorded in an exactly readable way on the object at the time of production. The at least one encrypted version of the first number is obtained by a method from public key cryptography. The recording of the at least one encrypted version thereby provides a second verification that verifies at the verification that the encrypted version of the first number was generated by an authorized party.

Information concerning the public key cryptography method is available so that the second verification can be made by anyone of an intended public.

## II. THE REJECTION BASED ON 35 USC §112, SECOND PARAGRAPH

Claims 1, 7, 16-18, and 46-51 stand rejected as being indefinite because the Examiner considers that the term “only essentially reproducible” in claim 1 renders this claim indefinite. Applicants respectfully disagree, since it is submitted that one having ordinary skill in the art would readily understand this terminology. However, in an attempt to expedite prosecution,

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Applicants have changed this terminology in an effort to find word choice satisfactory to the Examiner.

Relative to claim 16, the word "optional" is deleted.

Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

### III. THE PRIOR ART REJECTIONS

Applicants submit that the rejection currently of record fails to meet the initial burden of a *prima facie* rejection for the following reasons:

1. The Examiner continues to ignore the plain meaning of the claim language, as would be acceptable to one having ordinary skill in the art, concerning independent claims 1, 33-36, and 39. As previously explained by Applicants, in primary reference Naccache, the number p that is read by the scanner is not recorded as a number in addition to the encoded or encrypted number.

As best understood from the Examiner's comment in line 2 on page 17 of the Office Action, the Examiner considers that Naccache anticipates these independent claims because they fail to specify that the number from the scanner is recorded separately.

In response, Applicants submit that the plain meaning is clearly not satisfied in Naccache since the claim language in, for example, claim 39 requires that the number be recorded and the encrypted version of this number be recorded. Naccache records only an encrypted version. Therefore, Applicants submit that the plain meaning of this claim language is clearly not satisfied by Naccache and that claims 1, 33-36, and 39 are patentable over Naccache for this reason alone.

Hence, turning to the clear language of the claims, in Naccache, there is no teaching or suggestion of: "...recording, on at least one of said recording supports, at said time of production, in an exactly readable way, an exact value of said first number so that said first number ... and said first number is recorded as an unencrypted number", as required by independent claim 39. Other independent claims have similar wording.

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2. Regarding the Examiner's comment on page 18 concerning claim 8, Applicants submit that no additional wording is required, since the claim already requires that the initial reading includes more information than will be read in subsequent readings. The Examiner relies upon the description at line 67 of column 2, wherein is mentioned the RSA signature scheme. However, Applicants submit that one having ordinary skill in the art would not agree with the Examiner that a "signature scheme" is the same as the technique of gathering more information on the initial reading than on subsequent readings.

3. Relative to the modification of the primary reference Naccache by Kaish, Applicants again submit that such modification is improper for the following reasons:

3A. Primary reference Naccache addresses a portable rigid plastic card embedded with steel marbles. In contrast, secondary reference Kaish provides a flexible label that includes woven fibers that provide a random pattern. Applicants submit that Kaish cannot be used to modify with Naccache, since it is clear to one having ordinary skill in the art would recognize that the two references are not in any way compatible. The discrete steel balls embedded in the rigid plastic, as used in Naccache, provide a digital method, whereas, the dichroic fibers in the flexible label provide an analog method. That is, there would be no way that the dichroic fibers could be woven into the rigid plastic card.

As stated in MPEP §2143.01: "*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.*"

3B. Moreover, the Examiner relies upon lines 34-35 of column 22 of Kaish as the motivation to modify Naccache. Applicants submit that the Examiner attempts to take these words of Kaish out-of-context.

The description at lines 31-35 of column 22, that includes lines 34-35, actually describe the use of the label as a protection for copyrighted text. That is, if the woven fibers are used on paper containing copyrighted text, then the simple copying of that text, which is illegal under copyright law, the label can be used to detect the simple copying and thereby provides an aid for a legal remedy.

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This copyright scenario would not be possible using the rigid plastic card of Naccache, since the plastic card would not be used with paper containing copyrighted text. Therefore, the Examiner's rationale is not reasonable.

Therefore, Applicants submit that there is no reasonable motivation to modify Naccache with Kaish.

4. Relative to the use of Lien to modify Naccache, Applicants submit that there is no motivation on record for such modification.

5. Relative to the rejection for claim 9, the Examiner simply ignores the plain meaning of this claim, wherein two different processors are used.

6. Relative to the rejection of claims 26-29 and 47, Applicants submit that the steel marbles used in the primary reference Naccache will not change over time, in the sense of the present invention, or decay, in the sense of Kaish.

7. Relative to the rejection for claim 32, the Examiner points to no suggestion of a plurality of coded versions of numbers in any of the cited references.

8. Relative to the use of secondary references Basso, Liu, and Noyes, Applicants submit that these two references are non-analogous art and are not addressing the same problem addressed in primary reference Naccache and, therefore, are not proper to use as a secondary references. Nor are the solutions provided by these secondary references providing solution to any problem existing in Naccache.

9. Relative to the urged modification of Naccache by Bratchley, the steel marbles in Naccache are not subject to degeneration in the sense of the secondary reference.

10. Relative to the urged modification of Naccache by Kawano, the rigid card of Naccache does not lend itself to detecting changes of pressure, as required by Kawano. Nor does Kawano teach or suggest using a seal, as required by the claim language.

11. Relative to the urged modification of Naccache by destroying part of the card, in accordance with Swanberg, such modification would render the plastic card useless for its intended purpose. Therefore, in accordance with MPEP 2143.01 ("*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose then there is no suggestion or motivation to make the proposed modification.*"), Swanberg is not suitable as a secondary reference.

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12. Relative to the rejection for independent claim 42, the rejection currently of record makes no attempt to satisfy the plain meaning of the first claim limitation.

13. Relative to the rejection for claim 46, the rejection currently of record makes no attempt to satisfy the plain meaning of the claim limitations.

14. Relative to the rejection for claim 52, the rejection currently of record makes no attempt to satisfy the plain meaning of the third claim limitation.

#### IV. FORMAL MATTERS AND CONCLUSION

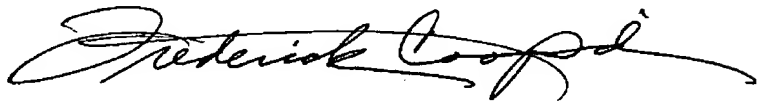
In view of the foregoing, Applicant submits that claims 1, 3, 4, and 7-53, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

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